REMARKS

Claims 96 to 111 and 115 to 122 are pending in this application. Applicants have cancelled claims 123 to 126 as directed to a non-elected invention. Applicants have amended claims 96, 100, 102, 103, and 111, and have canceled claims 112, 113, and 114 without prejudice. These amendments add no new matter.

Applicants acknowledge the Examiner's conclusion that the present application is entitled to an effective filing date of October 15, 1992.

Information Disclosure Statement (IDS)

The Office notes that the IDS filed on June 8, 2001 fails to comply with one or more requirements under 37 CFR 1.98(a)(1). Applicants respectfully submit that all of the prior art references listed in the IDS filed on June 8, 2001 were either cited by the Office or submitted by applicants to the Office in one or more parent applications (U.S. Serial No. 08/957,907 and 07/961,527) of the present case. Therefore, the Office should already have cited these references herein under MPEP 2001.06(b). However, in the interests of full disclosure and in moving the present application towards allowance, applicants have enclosed a new Form PTO-1449 for the Examiner's consideration and review. All of the references listed on this new form were listed on the original forms submitted on June 8, 2001, and all of the references were also submitted to or cited by the Office in the parent applications of the present application. Thus, copies of these references are already of record within the PTO and should be easily available to the Examiner. As a result, applicants are not submitting copies of the references in the present application. Of course, copies are available upon request.

Applicants request that the Examiner indicate that he has reviewed all of the references listed on the new Form PTO-1449, so that they will be listed on the face of the patent upon issuance. Applicants do not view the present filing as a new IDS, but merely a resubmission of the IDS and the prior art that were originally submitted on June 8, 2001. Thus, no additional fees are believed due.

Restriction

Applicants acknowledge the Examiner's restriction and confirm the election of Group I, claims 96-122. Applicants have cancelled claims 123-126 without prejudice.

35 U.S.C. § 112 - Enablement

Claims 96-106 have been rejected, because the specification allegedly does not fully enable the pending claims. Applicants traverse this rejection in view of the claim amendments and for the following reasons.

The Office states that the application enables an automated embodiment, but "does not reasonably provide enablement for [a] manual embodiment" (Office Action at page 7). Thus, the Examiner has suggested that applicants insert "automatically" before "reading" in line 5, before "transferring" in line 5, before "comparing" in line 7, before "configuring" in line 9, before "configuring" in line 10, and before "infusing" in line 11, to overcome this rejection.

Although applicants disagree that the term "automatically" needs to be inserted into the claim in such a redundant fashion, applicants have largely accepted the Examiner's suggestions, and have amended claim 96 accordingly. Applicants have also amended claims 100 and 102-104 in a similar fashion. However, applicants have not included the term "automatically" before "infusing" in the last step of claim 96, because all commercial infusion pumps currently require some form of operator confirmation before the pump actually causes the drug to be infused into the patient. Thus, it would not make sense to require that the last step of infusing be "automatic." Given the amendments, applicants request the Examiner to withdraw this rejection.

Claims 111-116 have been rejected because the specification allegedly does not fully enable the pending claims. Applicants traverse this rejection in view of the claim amendments and for the following reasons.

The Examiner concedes that the specification is "enabling for the label reader residing on the infusion pump (e.g., per claim 112) and the customized library residing in the memory of the infusion pump (e.g., per claim 114)," (Office Action at page 7), and thus proposes "'rolling up' claims 112 and 114, and cancelling claim 113," to overcome this rejection. Although applicants

disagree that claim 111 lacks enablement, applicants have accepted the Examiner's suggestions in the interests of moving this application towards allowance, and have amended claim 111 accordingly. Thus, applicants request that the Examiner withdraw this rejection.

Double Patenting

Claims 117-118 and 120-122 have been rejected on the ground of nonstatutory obviousness-type double patenting as being allegedly unpatentable over claims 20, 24, and 25 of U.S. Patent No. 5,681,285 in view of common knowledge in the art.

In addition, claims 96-98, 104, 107-116, and 119 have been rejected on the ground of nonstatutory obviousness-type double patenting as being allegedly unpatentable over claims 20 and 23-25 of U.S. Patent No. 5,681,285 in view of Arthur, III U.S. 4,978,335.

The Office has also rejected claims 99-103, 105, and 106 on the ground of nonstatutory obviousness-type double patenting as being allegedly unpatentable over claims 20 and 23-25 of U.S. Patent No. 5,681,285 in view of Arthur, III U.S. Patent No. 4,978,335, and further in view of common knowledge in the art and/or claims 1-19 of the '285 patent.

Applicants do not agree that the present claims are obvious as alleged by the Office. However, in the interests of moving this application to allowance, applicants enclose herewith a Terminal Disclaimer that overcomes the presently alleged rejections.

CONCLUSIONS

Applicants submit that all pending claims are now in condition for allowance, and request that the Examiner reconsider and withdraw all remaining rejections and initial all references cited on the new form PTO-1449 submitted herewith. No fees are believed due. Please apply any charges or credits to deposit account 06-1050, referencing attorney docket no. 00786-0157003.

Respectfully submitted,

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